

REMARKS

Favorable reconsideration of this application in light of the preceding amendments and the following remarks is requested.

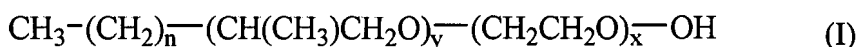
No claims having been canceled or added in this Response, the Applicants submit that 18 claims, specifically claims 1-3, 5-11, 14-17 and 28-31, remain pending and properly under consideration in this application. Claims 1, 5, 14 and 28 are written in independent form.

The Applicants acknowledge their obligations under 37 C.F.R. § 1.56 with respect to the identification of inventors for the pending claims, but submit that the claim amendments and/or cancellation or addition of claims have not warranted any modification of the original inventorship.

Rejections Under 35 U.S.C. § 102(b)

Claim 5 stands rejected under 35 U.S.C. § 102(b) as anticipated by Mizutari et al.'s JP 2001-110,760 ("Mizutari"). The Applicants traverse this rejection for the reasons detailed below.

The Applicants maintain that claim 5 further defines the claimed slurry compositions as comprising at least one alcohol selected from those compounds represented by groups I and II as defined in allowed claim 1:



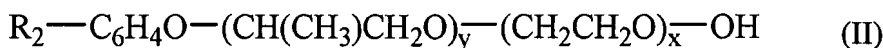
wherein

n is an integer satisfying the relationship $3 \leq n \leq 22$;

y is an integer satisfying the relationship $1 \leq y \leq 30$; and

x is an integer satisfying the relationship $1 \leq x \leq 30$;

and a second group of alcohols represented by the formula II



wherein

R₂ is -C₉H₁₉ or -C₈H₁₇.

The Applicants submit that the plain language of claim 5 requires that the claimed abrasive slurry composition include at least one component from each of the four identified groups of block copolymers and block tripolymers, *i.e.*, ***at least four components*** with at least one component corresponding to ***each of formulae I-IV***.

The Applicants maintain, therefore, that Mizutari's purported disclosure of two compounds corresponding to formulae III and IV (Mizutari's Type I and Type II respectively), Action at 2-3, does not include all of the recited components and cannot fairly be said to constitute a complete disclosure of each element of the claimed composition.

The Applicants contend that the absence in Mizutari of any noted teaching or suggestion of compounds corresponding to formula I or formula II as recited in claim 5 is sufficient to prevent this reference from being fairly characterized as sufficient to teach or suggest the claimed composition to one of ordinary skill in the art.

The Applicants request, therefore, that this rejection be reconsidered and withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Claims 6-10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mizutari for the reasons detailed in the Action at pages 3-4 . The Applicants traverse this rejection.

The Applicants incorporate the discussion above regarding the distinctions noted above between claim 5 and Mizutari, to define these compositions as including at least one alcohol corresponding to formula I and formula II in addition to those components attributed to Mizutari.

The Applicants submit that the claimed compositions are removed from the scope of compositions taught or suggested by Mizutari and are allowable over the prior art of record.

The Applicants request, therefore, that this rejection be reconsidered and withdrawn.

Rejections Under 35 U.S.C. § 112

Claims 6-10 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for including the introductory language “from a group consisting of” rather than “from the group consisting of” when introducing the recited Markush groups. The Applicants traverse this rejection.

The Applicants contend that MPEP § 2173.05(h) makes clear that a variety of formats are valid for presenting alternative limitations. The Applicants further note that from a purely antecedent basis analysis as applied to all other claim elements, the first recitation of “group” is properly introduced as “a group” with only subsequent references using “the group” terminology. The Applicants also note that a number of issued U.S. patents have claims incorporating the “a group consisting of” language for introducing a Markush group. *See, e.g.*, U.S. Pat. Nos. 5,433,226 and 6,379,961. Further, the Applicants contend that no logical or textual reasoning has been supplied to support the contention that one of ordinary skill in the art would actually find the rejected language “indefinite” with respect to the composition of the claimed group. Action at 4.

Accordingly, the Applicants suggest that the particular language Mr. Markush used in the 1920s should not be treated as some talismanic requirement, that the use of “the group” as the initial introductory language is inconsistent with the Office’s current antecedent basis protocols and further that the use of “a group” is not, in any sense, indefinite. Indeed, the Applicants note

that the presently rejected claim construction may be found even in internal USPTO training materials.¹

The Applicants maintain, therefore, that the pending language is not “indefinite” under any reasonable interpretation by one of ordinary skill in the art and that the rejection should be reconsidered and withdrawn accordingly.

In light of discussions with the Examiner, however, and as reflected above in the amended claims, the Applicants are willing to acquiesce to the Examiner’s and/or the Art Group’s preferences with regard to the style of the claimed Markush groups.

Allowed Claims

The Applicants note with appreciation the Examiner’s indication that claims 1-3, 11, 14-17 and 28-31 are allowed. As reflected above, however, the Applicants submit that claims 5-10 are also allowable over the prior art of record.

¹ <http://www.uspto.gov/web/patents/tc1600restrictionmaterials.pdf>, Example 1 - Claim Set at pages 7-10.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending rejections have been addressed and overcome, leaving the present application in condition for allowance. A Notice to that effect is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, PLC

By

John A. Castellano, Reg. No. 35,094

P.O. Box 8910
Reston, VA 20195
(703) 668-8000


JAC/GPB